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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,555	08/05/2003	Takashi Ohno	1405.1073	7151
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER WHIPPLE, BRIAN P	
			ART UNIT 2452	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/633,555	Applicant(s) OHNO ET AL.	
	Examiner BRIAN P. WHIPPLE	Art Unit 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 3-11, and 13-14 are pending in this application and presented for examination.

Response to Arguments

2. Applicant's arguments filed 9/8/09 have been fully considered but they are not persuasive.

3. As to claim 1, Applicant argues Sugano fails to disclose extracting “a part of information of watcher clients.” Applicant contends that instead Sugano discloses “the new identifier of the first client is notified to all recipients to which the UIO of the first client was sent in the past.”

Applicant's arguments are based on Sugano not disclosing notifying a subset of the recipients. However, the newly amended text does not require a subset of recipients be notified. Rather, the text merely requires extracting “a part of information of watcher clients.” In other words, Applicant's argument is based on a part of the watcher clients (i.e., a subset of the plurality of watcher clients), whereas the text merely describes “a part of information of watcher clients.” The part of information may be seen as extracting a piece of information from each of the watcher clients. This is done in Sugano as information

“corresponding to receiving users who previously received a corresponding transmitted UIO” must be extracted in order to determine who has previously been contacted and therefore must be sent the updated UIO (as disclosed, at least in part, by the section cited by Applicant of Col. 18, ln. 10-14 and the section cited by Examiner in Col. 18, ln. 65 – Col. 19, ln. 2).

Accordingly, nothing in the claim precludes the notification of all recipients. Rather, the text merely requires a part of information of each watcher client being extracted.

4. As to claim 4, Applicant argues Sugano fails to disclose “extracting at least one of a plurality of watcher clients of the first client based on the notification history, and deciding to be one or more identifier notification recipients.” Applicant states, “In contrast, Sugano discusses transmitting updates based on all recipients of the UIOs.”

Again, the Examiner maintains that the language of the claim does not preclude all recipients from being notified. Sugano discloses extracting information on which recipients have previously received a corresponding UIO (i.e., a notification history) and deciding the recipients are to identifier notification recipients (Col. 18, ln. 10-14). Nothing in the claim eliminates all recipients from being notified, as notifying the group of all recipients would be “at least one of” the recipients and “one or more identifier notification recipients.” In other words, the claim is directed to at least one, but does not state the at least one cannot be the entire group.

Furthermore, even the group corresponding to users in the network who have previously received a corresponding UIO is itself a subset of the entire group of users in the network who have and **have not** received the corresponding UIO.

5. The remaining claims are argued solely based upon the arguments presented for claim 1 and therefore the rejections are maintained in light of the Examiner's disagreement over the allowability of claim 1.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-11, and 13-14 are rejected under 35 U.S.C. 102(b) as anticipated by Sugano et al. (Sugano), U.S. Patent No. 6,205,478 B1.

8. As to claim 1, Sugano discloses a client administration method of administering a group of clients (Abstract, ln. 1-3), each client providing presence information (Col. 7, ln. 47-49), the method comprising:

accepting a setting of presence information of the clients including a first client, and storing the presence information on a client by client basis (Col. 7, ln. 40-43 and 47-49; Col. 19, ln. 2-6);

storing a watcher list for each of clients in the clients group (Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36), the watcher list correlating at least one identifier of a watcher client with an identifier of a client owning the watcher list (Col. 16, ln. 28-30; Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36), each watcher client being provided with the presence information of a client owning the watcher list (Col. 18, ln. 65 – Col. 19, ln. 2; Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36);

accepting a change of an identifier of the first client (Fig. 2, item 7; Col. 19, ln. 12-25);

extracting a part of information of watcher clients of the first client to be one or more identifier notification recipients according to the change of the identifier of the first client (Fig. 2, item 7; Col. 19, ln. 12-25; Col. 23, ln. 36-43);

replacing, in a watcher list of the first client, an old identifier of the first client with a new identifier, and replacing identifiers of all watcher clients with one or more identifiers of the extracted notification recipients (Col. 22, ln. 19-22; Col. 24, ln. 37-43; Col. 27, ln. 55-66; Col. 29, ln. 20-23 and 34-36), and

transmitting a new identifier of the first client to one or more identifier notification recipients identified in said extracting (Col. 22, ln. 6-18; Col. 23, ln. 36-43).

9. As to claim 3, Sugano discloses storing identifiers of subscriber clients so that each subscriber client is associated with at least one client that provides the presence information thereto, the subscriber client being provided with the presence information of at least one client of the clients group (Col. 7, ln. 47-49; Col. 16, ln. 28-30; Col. 18, ln. 65-67; Col. 19, ln. 1-2; Col. 27, ln. 55-66); and

extracting a client to be an identifier notification recipient, the client being both a watcher client of the first client and a subscriber client of the first client (Col. 23, ln. 36-43).

10. As to claim 4, Sugano discloses notifying the first client's watcher client of new presence information according to the setting of the presence information (Col. 7, ln. 47-49; Col. 26, ln. 12-41);

storing a notification history of the presence information (Col. 9, ln. 25-29; Col. 22, ln. 65-67; Col. 23, ln. 1-3); and

said extracting including extracting at least one of a plurality of watcher clients of the first client based on the notification history, and deciding to be one or more identifier notification recipients (Col. 18, ln. 10-14; Col. 19, ln. 12-25; an update notification is transmitted to each of the user terminals corresponding to receiving users who previously

received a corresponding transmitted UIO; transmitting based on previous recipients is an extraction step based on notification history).

11. As to claim 5, Sugano discloses administering distribution of text messages exchanged between the clients (Fig. 3; Col. 21, ln. 39-48);

storing a distribution history of distributed text messages (Fig. 3; Fig. 4; Col. 9, ln. 25-29; Col. 18, ln. 10-14; Col. 22, ln. 65-67; Col. 23, ln. 1-3); and

said extracting including extracting at least one of a plurality of watcher clients of the first client based on the distribution history, and deciding to be one or more identifier notification recipients (Col. 18, ln. 10-14; transmitting based on previous recipients is an extraction step based on distribution history).

12. As to claim 6, Sugano discloses said storing of the presence information of the clients includes associating the presence information with an access level, the access level limiting notification recipients of the presence information of the clients (Col. 19, ln. 63-67; Col. 20, ln. 1-15);

the access level of each watcher client (Col. 19, ln. 63-67; Col. 20, ln. 1-5) is stored;
and

a portion of a plurality of watcher clients of the first client is determined to be the identifier notification recipients based on the access level of each watcher client (Col. 20, ln. 30-61; Level 5 users are not issued a UIO and no items are accessible).

13. As to claim 7, Sugano discloses transmitting display data for displaying the change of the identifier of the first client to one or more identifier notification recipients (Col. 25, ln. 19-36).

14. As to claim 8, Sugano discloses transmitting attribute information related to the change of the identifier of the first client to one or more identifier notification recipients (Fig. 3; Col. 22, ln. 6-18).

15. As to claim 9, Sugano discloses accepting registration of the attribute information (Col. 22, ln. 19-22).

16. As to claims 10-11 and 13-14, the claims are rejected for reasons similar to claim 1 above.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the Notice of References Cited (PTO-892).

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (11:30 AM to 6:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on 571-272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian P. Whipple
/B. P. W./
Examiner, Art Unit 2452
11/15/09

/THU NGUYEN/
Supervisory Patent Examiner, Art Unit 2452